



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/649,042

08/26/2003

Masayuki Chatani

SONYP026

4966

25920 7590 05/06/2010
MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE, CA 94085

EXAMINER

KUCAB, JAMIE R

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

05/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/649,042	Applicant(s) CHATANI, MASAYUKI	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13, 15-17 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 15-17, and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. Applicant's response filed February 24, 2010 is acknowledged.
2. Claims 1-6, 8-13, 15-17, and 24 are pending in the application.
3. Claims 1-6, 8-13, 15-17, and 24 are examined below.
4. This Office action is given Paper No. 20100504 for reference purposes only.

Claim Rejections - 35 USC § 112, Second Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1-6, 8-13, 15-17, and 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. The claims are replete with errors. Examples of errors in the claims follow.

7. Regarding claim 1, Applicant's recitation "receiving the digital authentication ticket separate from a location of the particular computer readable content" would have been unclear to a person having ordinary skill in the art at the time of the invention. Does this mean that both a location and a digital authentication are received separately? Or does this mean that the receiving is done at a location that is different from the location of the computer readable content? For the purpose of comparison with the prior art, the Examiner is adopting the latter interpretation.

8. Regarding claim 9, Applicant's recitation "wherein the client device obtains the digital authentication ticket via a communication network separate from the particular computer readable content" would have been unclear to a person having ordinary skill in the art at the time of the invention. Does this mean that communication network is separate from the particular computer readable content? Or does this mean that the computer readable content and the digital authentication ticket are obtained separately? For the purpose of comparison with the prior art, the Examiner is adopting the latter interpretation.

9. Claim 24 contains language similar to that of claim 9 as discussed in the previous paragraph. Claim 24 is rejected under the same reasoning as applied to claim 9 above.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6, 8-13, 15, 16, and 24, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohmori et al. (US Patent No. 7,020,636, hereafter, "Ohmori") in view of Maritzen et al. (US PGPub 2002/0184500, hereafter "Maritzen").

12. Regarding claims 1, 9, 15, 16, and 24, Ohmori discloses method/system for controlling access to computer readable content, comprising the operations of:

- a. receiving a digital authentication ticket (step S208, Fig. 14), obtained by a client device ("IC CARD 20," Fig. 1) and saved in memory of the client device, before being transmitted to a computer system ("DVD PLAYER 40," Fig. 1) having particular computer readable content ("ENCRYPTED CONTENT FROM DVD"), wherein the digital authentication ticket includes a digital code ("title key");
- b. transferring (step S174, Fig. 10) the digital authentication ticket wirelessly (C27 L22-25) from the client device to the computer system;
- c. determining, at the computer system, whether the digital authentication ticket corresponds to the particular computer readable content when the digital authentication is obtained ("DECRYPT ENCRYPTED CONTENT USING TITLE KEY," step S164, Fig. 10);
- d. allowing access to the particular computer readable content at the computer system when the digital authentication ticket corresponds to the particular computer readable content ("REPRODUCE AND OUTPUT CONTENT," step S165, Fig. 10);
- e. preventing access to the particular computer readable content at the computer system when the digital authentication ticket does not correspond to the particular computer readable content (inherently, because the content is encrypted, therefore, if the title key does not correspond to the encrypted content, the result of the decryption step would not be unencrypted content but rather unintelligible garbage);

- f. invalidating the digital code after allowing access to the particular media to prevent unlocking of additional media content without purchase (“...judge whether the digital work is allowed to be used when the elapsed date and time is on or after the present date and time,” C4 L7-39; or, alternately, “the number of times reproduction is allowed can be set,” C4 L40-56); and
 - g. wherein the client device obtains the digital authentication ticket via a communication network (“COMMUNICATION LINE 60,” Fig. 11), the client device being capable of obtaining the digital authentication ticket anywhere the client device has access to the communication network (at the SHOP APPARATUS 10).
- 13. However, Ohmori fails to explicitly disclose the digital code being separate from the particular computer readable content and receiving the digital authentication ticket separate from a location of the particular computer readable content
- 14. Maritzen teaches the digital code being separate from the particular computer readable content and receiving the digital authentication ticket separate from a location of the particular computer readable content (see, for example, Fig. 1, which shows that the physical distribution channel of the content is separate from the electronic distribution channel of the electronic ticket).
- 15. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method/system of Ohmori to include the separate delivery of Maritzen in order to achieve the predictable result of allowing the token/ticket purchase

to be made electronically while the content is delivered over physical distribution channels.

16. As to claim 2, Ohmori further discloses the operation of transmitting the digital authentication ticket to the client device in response to receiving a request for the digital authentication ticket (step S122, Fig. 13).

17. As to claims 3 and 10, Ohmori further discloses the operation of processing the request for the digital authentication ticket, wherein the processing includes charging a fee to a user ("the rental agent receives a user's payment for the rental," C2 L57-58).

18. As to claims 4 and 11, Ohmori further discloses wherein the request is received using a payment server ("SHOP APPARATUS 10," Fig. 1) located remotely from the client device (see Fig. 1).

19. Regarding claims 5 and 12, Ohmori further discloses the operation of transmitting the digital authentication ticket from a game server ("SERVER APPARATUS") to the payment server (step S207, Fig. 14), the game server storing a plurality of digital authentication tickets (inherently, because DVD rental stores do not stock just a single title).

20. As to claims 6 and 13, Ohmori further discloses wherein the computer system is located locally to the client device (see Fig. 1).

21. Regarding claim 8, Ohmori further discloses wherein the digital authentication ticket is transmitted wirelessly from the payment server to the client device (C27 L22-25).

22. Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ohmori/Maritzen in view of Ginter et al. (US Pat. No. 5,892,900 hereafter "Ginter").

23. Regarding claim 17, Ohmori/Maritzen discloses all the elements of the claimed invention as detailed above, but Ohmori/Maritzen fails to explicitly disclose wherein the game server transmits the computer readable content to the computer system.

24. However, Ginter teaches wherein the game server ("CONTENT CREATOR 102") transmits the computer readable content to the computer system ("CONTENT USER 112," Fig. 2A).

25. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method/system of Ohmori/Maritzen to include the transmitting from game server to computer system of Ginter in order to achieve the predictable result of streamlining delivery of content and reducing the inventory burden on the owner of the payment server.

Claim Interpretation

26. Independent claims (1, 9, and 24) are examined together, since they are not patentably distinct. If Applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Response to Arguments

27. Applicant's arguments with respect to the §102 and §103 rejections of the claims are moot in view of the new rejections above.

Conclusion

28. Applicant's amendment filed February 24, 2010 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

29. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

Furthermore, suggestions or examples of claim language provided by the Examiner are just that--suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not* been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

31. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

32. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>.

Should you have questions on access to the Private PAIR system, contact the
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621